

## REMARKS

The present application was filed on January 23, 2002. In a Preliminary Amendment filed concurrent with the present application, Applicants canceled without prejudice claims 30-36 and 38-51. Thus, claims 1-29 and 37 remain pending with claims 1, 13, 21, 29 and 37 being the independent claims.

In the outstanding Office Action, the Examiner: (i) rejected claims 1-16, 20-29 and 37 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,199,099 to Gershman et al. (hereinafter “Gershman”) in view of U.S. Patent Application No. 2004/0199765 to Kohane et al. (hereinafter “Kohane”); (ii) rejected claims 17 and 18 under 35 U.S.C. §103(a) as being unpatentable over Gershman in view of Kohane and further in view of U.S. Patent No. 6,182,124 to Lau et al. (hereinafter “Lau”); and (iii) rejected claim 19 under 35 U.S.C. §103(a) as being unpatentable over Gershman in view of Kohane and Lau and further in view of U.S. Patent Application No. 2001/0014868 to Herz (hereinafter “Herz”).

Regarding the §103(a) rejection of claims 1-16, 20-29 and 37, Applicants respectfully assert that the Gershman/Kohane combination fails to establish a prima facie case of obviousness under 35 U.S.C. §103(a), as specified in M.P.E.P. §2143.

As set forth in M.P.E.P. §2143, three requirements must be met to establish a prima facie case of obviousness. First, the cited combination must teach or suggest all the claim limitations. Second, there must be a reasonable expectation of success. Third, there must be some suggestion or motivation to combine reference teachings. While it is sufficient to show that a prima facie case of obviousness has not been established by showing that one of the requirements has not been met, Applicants respectfully believe that none of the requirements have been met.

First, Applicants assert that the Gershman/Kohane combination fails to teach or suggest all of the limitations of the claims. For at least this reason, a prima facie case of obviousness has not been established.

Independent claim 1 recites a method for use in a distributed data network wherein a user may request and receive content from one or more entities in the distributed data network comprising the steps of providing one or more mechanisms for enabling at least one of the user and one or more of the entities to control which entities in the distributed data network have access to information generated in association with the user’s activity on the distributed data network, and customizing content to be received by the user in accordance with at least a portion of the accessible information. Independent claims 21 and 37 recites similar limitations.

Independent claim 13 recites a method for use in accordance with at least one server in a distributed data network wherein a user may request and receive content from one or more entities in the distributed data network comprising the steps of maintaining two or more user-specified policies respectively associated with two or more roles within which the user may perform activities on the distributed data network, and issuing access credentials associated with the user-specified policies to one or more entities that seek to access information generated in association with the user's activity on the distributed data network so as to customize content to be received by the user in accordance with at least a portion of the accessible information. Independent claim 29 recites similar limitations.

As illustratively explained in the present specification at page 3, line 12, through page 4, line 21:

The present invention provides techniques for global customization of network content with privacy mechanisms such that, in one aspect of the invention, a user may control what information an entity can learn about the user's activity at other entities, and, in another aspect of the invention, a particular entity may control what information is revealed to competing entities. In a preferred embodiment of the invention, the entities are merchants.

Accordingly, the inventive techniques enable global profiles of each user's behavior to be maintained, so that a merchant can customize content for a user based on that user's activities, even at other merchants. At the same time, however, the techniques are privacy-preserving, in the sense that users and merchants can control how information about them is shared. Specifically, the inventive techniques enable each user to control which of his or her information can be gathered together in a profile, and does so with natural extensions to the user's browsing experience. It also enables each merchant to specify which other merchants can learn the information that it contributes to a profile and/or other information derived therefrom. As mentioned above, existing approaches lack such data protection models.

(Underlining added above for emphasis).

Gershman discloses a mobile computing environment that accesses the Internet to obtain product information for a user utilizing a distributed communication network (column 1, lines 9-12). Kohane discloses a method for maintaining confidential records, such as medical records, of an individual over a publicly accessible network. However, the combination of Gershman and Kohane fails to teach or suggest all of the limitation of independent claims 1, 13, 21, 29 and 37.

For example, with regard to independent claims 1, 21 and 37, the combination of Gershman and Kohane does not provide "one or more mechanisms . . . to control which entities in the distributed data network have access to information generated in association with the user's activity on the distributed data network and then customizing content to be received by the user in

accordance with at least a portion of the accessible information,” as in the claimed invention. Nor does the combination of Gershman and Kohane provide “access credentials . . . to access information generated in association with the user’s activity on the distributed data network so as to customize content to be received by the user in accordance with at least a portion of the accessible information,” as in independent claims 13 and 29.

While Gershman discloses updating user profiles by watching user activities (column 39, lines 6-24), there is absolutely no notion of access control relating to such user profiles. While Kohane discloses the notion of maintaining confidentiality, the information for which confidentiality is being maintained is a medical record, not “information generated in association with the user’s activity on the distributed data network,” as recited in the independent claims.

The Office Action states at page 3 that Gershman discloses “customizing content to be received by the user in accordance with at least a portion of the accessible information.” However, there is no notion of access control in Gershman, therefore, Gershman can not teach what the Office Action alleges.

Second, Applicants assert that there is no reasonable expectation of success in achieving the present invention through a combination of Gershman and Kohane. For at least this reason, a prima facie case of obviousness has not been established. Despite the assertion in the Office Action, Applicants do not believe that Gershman and Kohane are combinable since it is not clear how one would combine them. There is no guidance provided in the Office Action.

As mentioned above, Gershman discloses a mobile computing environment that accesses the Internet to obtain product information for a user utilizing a distributed communication network, wherein user profiles may be updated by watching user activities. Kohane discloses techniques for maintaining confidentiality of a record, such as a medical record, over a public network. However, the techniques by which Kohane maintain confidentiality are through standard encryption techniques, wherein agents having certain privileges may access the medical record.

It is completely unclear how one would modify the user profile information or the techniques of Gershman to maintain confidentiality through standard encryption techniques as disclosed in Kohane in order to “provide one or more mechanisms for enabling at least one of the user and one or more of the entities to control which entities in the distributed data network have access to information generated in association with the user’s activity on the distributed data network, and customize content to be received by the user in accordance with at least a portion of the accessible information,” as in claims 1, 21 and 37, or to “maintain two or more user-specified policies

respectively associated with two or more roles within which the user may perform activities on the distributed data network, and issue access credentials associated with the user-specified policies to one or more entities that seek to access information generated in association with the user's activity on the distributed data network so as to customize content to be received by the user in accordance with at least a portion of the accessible information," as in claims 13 and 29.

Lastly, there is a clear lack of motivation to combine the references. For at least this reason, a prima facie case of obviousness has not been established. Gershman is directed to a technique for providing product information to a user in a mobile computing environment wherein user profiles may be updated based on user activities, while Kohane is directed to a technique for maintaining confidentiality of records over a public network. That is, the teachings in each reference are directed to completely different environments; one (Gershman) toward provision of product information to a user in a mobile computing environment, the other (Kohane) toward a technique for maintaining confidentiality of records over a public network. However, other than very general and conclusory statements in the Office Action, there is nothing in the two references that reasonably suggests why one would actually combine the teachings of these two references.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that "conclusory statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." *Id.* at 1343-1344.

In the Office Action at page 4, the Examiner provides the following statement to prove motivation to combine Gershman and Kohane, with emphasis supplied: "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because Kohane's teaching would have allowed Gershman's to provide adequate confidentiality of the confidential records, mobility of the individual for accessing the records, security of the confidential records, and control of the confidential records by the individual as suggested by Kohane . . . ."

Applicants submit that this statement is based on the type of "subjective belief and unknown authority" that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner merely states mutually exclusive features of each

reference: "adequate confidentiality of the confidential records" (presumably Kohane), "mobility of the individual for accessing the records" (presumably Gershman), "security of the confidential records" (presumably Kohane), and "control of the confidential records by the individual" (presumably Kohane). However, such statements fail to identify any objective evidence of record which point out what would motivate one to combine these mutually exclusive features of Gershman and Kohane.

Accordingly, Applicants assert that independent claims 1, 13, 21, 29 and 37 are patentable over the cited combination and therefore allowable.

It is also asserted that dependent claims 2-12, 14-16, 20 and 22-28 are patentable over the cited combination due not only to their respective dependence on independent claims 1, 13 and 21 and the reasons given above, but also because such claims recite patentable subject matter in their own right.

By way of example only, with regard to claims 4 and 5, the Office Action at page 4 states that Gershman discloses "substantial unlinkability" of profiles. However, no where does Gershman mention "substantial unlinkability" of profiles, including the portion cited in the Office Action for support, namely, column 32, lines 30-52.

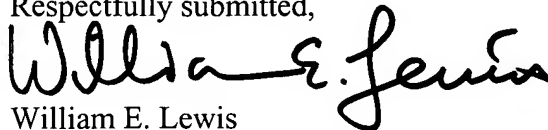
Further, by way of example only, despite the assertion in the Office Action at page 5 with regard to claims 8, 9 and 22, Gershman and its "Intelligent Agent Coordinator" are silent as to any notion of access control.

Regarding the §103(a) rejections of claims 17-19, Applicants assert that neither Lau nor Herz remedy the above-noted deficiencies of Gershman and Kohane. Also, such claims recite patentable subject matter in their own right. Accordingly, Applicants assert that such claims are patentable over the cited combinations and therefore allowable.

In view of the above, Applicants believe that claims 1-29 and 37 are in condition for allowance, and respectfully request withdrawal of the §103(a) rejections.

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Respectfully submitted,



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